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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,958	08/14/2006	Mirko Danz	DANZ-4	8432
20151 7590 10/07/2008 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017				
EXAMINER				
DALENCOURT, YVES				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/597,958

Applicant(s)

DANZ ET AL.

Examiner

Yves Dalencourt

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 04/11/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to communication filed on 08/14/2006.

Specification

The abstract of the disclosure is objected to because the phrase "the aim of the invention". It is suggested to start the abstract with --- An improved configuration of an automation system ---. Also the term "means" (line 3) is implied and should be deleted. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

Claim 15 objected to because of the following informalities: It is suggested to delete “ , ” (after component in line 6), and insert --- ; ---. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 25, the limitation of “of automatically loading an existing configuration data record in the client in the server ” is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 15 – 20 and 22 - 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumbalimutt et al (US 7,266,594; hereinafter Kumbalimutt) .

Regarding claims 15, 25, and 26, Kumbalimutt discloses a method for automatic configuration of an automation component of an automation system (figs. 3 – 5), comprising the steps of providing a server having stored therein a plurality of configuration data records (154, 156, fig. 3; col. 3, line 47 through col. 4, line 6); connecting a server to a client via communication means to thereby define an automation component (col. 3, lines 53 – 55; col. 7, line 66 through col. 8, line 4)), request by the client to the server for receiving one of the configuration data records (col. 4, lines 6 - 8); transmitting the requested configuration data record by the server to the client (col. 4, lines 8 - 12); and storing of the transmitted configuration data record in the client (col. 4, lines 12 - 16).

Regarding claim 16, Kumbalimutt discloses the method of claim 15, wherein the requested configuration data record of the plurality of configuration data records is selected in dependence on the functionality of the client (col. 4, lines 28 - 42).

Regarding claim 17, Kumbalimutt discloses the method of claim 15, wherein the server stores a plurality of configuration data records in correspondence with a functionality of the client (col. 3, line 47 through col. 4, line 6).

Regarding claim 18, Kumbalimutt discloses the method of claim 15, further comprising the step of autonomous identification of the client within a defined machine context (col. 4, lines 28 - 47).

Regarding claim 19, Kumbalimutt discloses the method of claim 15, wherein at least two of the plurality of configuration data records are stored locally in the client (col. 4, lines 12 - 16).

Regarding claim 20, Kumbalimutt discloses the method of claim 19, further comprising the step of operating the client by activating one of the at least two stored configuration data records in the client (col. 4, lines 51 - 56).

Regarding claim 22, Kumbalimutt discloses the method of claim 15, wherein the client communication is matched to the automation system to enable operation of the client during continuous operation of the automation system (col. 4, lines 48 - 54; Kumbalimutt discloses that the client computer 150 may have been previously configured to use server computer 154 as its Session Initiation Protocol (SIP) server).

Regarding claim 23, Kumbalimutt discloses the method of claim 15, wherein the client and the server operate on a single automation device (figs. 3 - 5).

Regarding claims 24 and 27, Kumbalimutt discloses the method of claim 15, further comprising the step of loading the configuration data records for different machine upgrade levels for a machine in the server by an engineering system (fig. 4; col. 4, lines 2 - 9; Kumbalimutt discloses inherently that the configuration settings were already loaded on the server).

Claim 28 incorporate substantively all the limitations of claim 15, in system form, rather than in method form. The reasons for rejecting claim 1 apply to claim 28. Therefore, claim 28 is rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumbalimutt et al (US 7,266,594; hereinafter Kumbalimutt) in view of Righi et al (US 7,363,480; hereinafter Righi).

Regarding claim 21, Kumlimutt discloses substantially all the limitations in claim 15, but fails to specifically teach the steps of storing pollable firmware data records in

the server, request by the client to the server for receiving one of the firmware data records, and storing and activating the received firmware data record in the client.

However, Righi discloses an analogous method, system, and computer-readable medium for updating the firmware of a computing device via a communications network which comprises the steps of storing pollable firmware data records in the server, request by the client to the server for receiving one of the firmware data records, and storing and activating the received firmware data record in the client (figs. 2A & 2B; see abstract; col. 2, lines 24 – 59; col. 3, lines 26 – 33).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kumbalimutt bi incorporating the steps of storing pollable firmware data records in the server, request by the client to the server for receiving one of the firmware data records, and storing and activating the received firmware data record in the client as evidenced by Righi for the purpose of assisting with the start up of the client and enabling communication with the low level hardware of the client system, thereby providing an efficient way of configuring a computer /client system.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272 4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 28, 2008

/Yves Dalencourt/
Primary Examiner, Art Unit 2157